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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,576	01/16/2001	Michael Trenk	P/2167-250	2902
21967	7590	11/07/2005	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 11/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/760,576	<b>Applicant(s)</b> TRENK ET AL.	
	<b>Examiner</b> JAGDISH PATEL	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/21/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This communication is in response to amendment filed 8/8/05.

#### ***Specification***

2. The abstract of the disclosure is objected to because it contains more than 150 words.

Correction is required. See MPEP § 608.01(b).

#### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 8/21/2001 has been considered in response to receipt of the copies of cited documents.

#### ***Response to Amendment***

4. Claim 9 has been amended. Claims 1-26 are currently pending.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejections.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8 and 19-26 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

See MPEP 2164.08(c) Critical Feature Not Claimed

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A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. 112. See *In re Mayhew*, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976). In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. In *re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

The following method step(s) are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

7. Regarding claims 1-8 the disclosure teaches that the first party (a company) must sell assets to the to the second party (a trading house) for a (first) value in order that the step of obligating the first party with a first obligation ( promise of future purchases) from the second party. In other words, the steps of the first party selling assets to the second party in exchange for a first value and obligating the first party with a first party are so intertwined that they cannot be separated. The examiner suggests the following exemplary amendment to remedy this deficiency.

8. In claim 1, replace the first obligating step to read:  
selling assets by a first party to a second party in exchange for first money;  
obligating the first party with a first obligation to purchase goods/services from the  
second party in conjunction with the selling of the assets

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9. Claims 1-8 and 19-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 1 recites “funding the trust with the second money”. There is no other step which relate to the second money in the trust. This renders the claim indefinite. It is suggested that the applicant amend the allowing step to read “allowing the third party to take a portion of the second money from the trust if ...”

***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. **Claims 9-18 recite Non-functional Data Structure and do not pertain to a permissible statutory class.**

Claims 9-18 are rejected under 35 USC § 101 because the claimed inventions are directed to non-statutory subject matter. Claims 9-18 are directed to **disembodied data structure** which are per se are not statutory (*In re Warmerdam*, No. 93-1294 (Fed. Cir. August 11, 1994)).

Note that functional descriptive material consists of data structure and computer programs which impart functionality when employed as a computer component. Nonfunctional

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descriptive material includes but is not limited to music, literary works and a compilation or mere arrangement of data. In the instant case, the contractual arrangement is mere arrangement of data that describe a contract terms and conditions, such data cannot impart any functionality (i.e. the obligations are not capable of performing any function, even if employed as a computer component). Therefore, it is asserted that claims 9-18 are directed to a non-statutory subject matter. (see also additional analysis provided below.).

**10. Claims nor directed to statutory a class of invention.**

In the present case, the claimed data structure is mere arrangement of data without any associated functionality. A contractual arrangement is nothing more than a written document having a plurality of stipulations (such as terms and conditions). A claimed invention must be directed to one of the permissible statutory classes namely, a process, machine, manufacture, or composition of matter (see 35 USC 101 code). The instant claims do not fall in any one of these statutory classes and therefor are directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ashenmil et al. (US 6,615,187).

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Per claim 26 Ashenmil discloses a method for securitizing cash flow (see at least col. 2 L 23- 38 “ ..future cash flows can be securitized” and “securitization can be used to finance any cash flow” and col. 9 L 41, asset based securitization).

Ashenmil fails to teach that the source of the cash flow as specifically derived from a future obligation to purchase goods or services.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The securitizing step itself does not depend upon how the cash flow is derived. Thus, this non-functional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to securitizing cash flow regardless of how the cash flow is derived because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Conclusion***

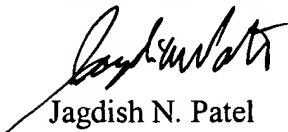
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

9/13/05